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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78277681
Applicant	Hotels.com, L.P.
Applied for Mark	HOTELS.COM
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Date	05/14/2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re the Matter of:

Application Serial No. 78/277,681

Mark: HOTELS.COM

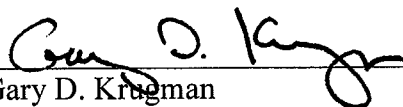
Applicant: Hotels.com, L.P.

Filing Date: July 23, 2003

**NOTICE OF APPEAL TO THE UNITED STATES COURT OF
APPEALS FOR THE FEDERAL CIRCUIT**

Applicant, Hotels.com, L.P., by its attorneys, hereby appeals, pursuant to Trademark Rule 2.145(a), to the United States Court of Appeals for the Federal Circuit from the final decision dated March 24, 2008 of the Trademark Trial and Appeal Board denying registration to Applicant of the mark in U.S. Trademark Serial No. 78/277,681.

Respectfully submitted,



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Date: May 14, 2008

THIS OPINION IS A
PRECEDENT OF THE TTAB

Oral Hearing: October 18, 2007

Mailed: March 24, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hotels.com, L.P.

Serial No. 78277681

Gary D. Krugman, Kevin G. Smith and Jody H. Drake of Sughrue
Mion, PLLC for Hotels.com, L.P.

Tarah Hardy Ludlow, Trademark Examining Attorney, Law Office 110
(Chris A. F. Pedersen, Managing Attorney).

Before Walters, Holtzman and Rogers, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Hotels.com, L.P., filed an application to
register the mark HOTELS.COM (in typed form) on the Principal
Register for services ultimately identified as:¹

¹ Application Serial No. 78277681; filed July 23, 2003; alleging a date of first use and first use in commerce on March 25, 2002. Applicant amended the application on August 4, 2004 to allege a date of first use anywhere and in commerce in a different form (HOTEL.COM) in 1997. The application includes a claim of ownership of Registration Nos. 2918738 and 2793744. Registration No. 2918738 is for the mark HOTELS.COM (and design) for "providing information for others about transportation; travel agency services, namely, making reservations and bookings for transportation for others by means of telephone and the global computer network" in Class 39. This mark is registered on the Principal Register without a disclaimer or a Section 2(f) claim. Registration No. 2793744 is for the mark 1 800 USA HOTELS.COM (in

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providing information for others about temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network, in Class 43.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that the mark is merely descriptive of the services, that applicant's evidence of acquired distinctiveness under Section 2(f) of the Act is insufficient, and that the mark is generic and incapable of registration under Section 2(f).² Applicant has appealed from the refusal.

Prior Board decision

At the outset, we note that the issues in this case were the subject of a prior Board proceeding in related application Serial No. 76414272. That case involved the same applicant, the same term, HOTELS.COM, and the same services as those herein.

typed form) for "discount travel agency services, namely, making reservations and bookings for transportation" in Class 39; and "discount travel agency services, namely, making reservations and booking for temporary lodging" in Class 43. This mark is registered on the Principal Register under Section 2(f) of the Act.

² The application also originally included services in Class 39, "providing information for others about transportation; travel agency services, namely, making reservations and bookings for transportation for others by means of telephone and the global computer network." At applicant's request, and because the refusal on the basis of genericness only applied to Class 43, Class 39 was divided out of this application. That application subsequently issued into Registration No. 3015723 on the Principal Register with a claim of acquired distinctiveness under Section 2(f).

Proceedings in the present appeal were suspended on July 26, 2005 at applicant's request pending the outcome of the earlier case.

In that case, applicant sought to register the composite mark shown below on the Principal Register for the same services in Class 43.³



In a decision issued September 11, 2006 ("HOTELS.COM I") (reconsideration denied, October 24, 2006, "HOTELS.COM I Recon."), the Board affirmed the examining attorney's requirement for a disclaimer of HOTELS.COM under Section 6(a) of the Trademark Act finding that the composite mark was not unitary and that the term HOTELS.COM was generic. However, the Board alternatively held that if the term was ultimately found not to be generic, applicant's evidence was sufficient to support a claim of acquired distinctiveness under Section 2(f), and the Board accordingly reversed the examining attorney's refusal to accept this evidence. Copies of the decisions are attached.

³ As in the present application, the earlier application also initially included Class 39. That class was divided out of the application and the application ultimately issued into Registration No. 2918738 under Section 2(f) on the Principal Register.

Applicant did not appeal the Board's decision in that case. Instead, as permitted by the Board, applicant submitted the required disclaimer of HOTELS.COM, and the decision was accordingly set aside. The application subsequently issued as Registration No. 3337609 on the Principal Register with a disclaimer of HOTELS.COM.⁴

In view of the adverse decision in the prior case, and during suspension of the present appeal, applicant commissioned a survey to determine the significance to the public of the term HOTELS.COM. After the survey was completed, applicant requested remand of the application to the examining attorney for reconsideration of the refusal in light of this new evidence. When the examining attorney rejected the survey evidence as unpersuasive, the appeal in this case was resumed. Briefs were then filed in this case and an oral hearing was held.

Res Judicata

The examining attorney argues in her brief that in view of the prior Board proceeding involving the same applicant and, as applicant admits, the same issues, the claim presented in this appeal, i.e., that HOTELS.COM is not generic and may be registered on a showing of acquired distinctiveness, is barred by res judicata. We note that the two applications were handled

⁴ It appears that the registration has mistakenly issued with a Section 2(f) claim.

by different examining attorneys, but the evidence of genericness, if not the same, is essentially of the same type and substance. Also, apart from the newly submitted survey evidence, applicant's evidence in rebuttal to the examining attorney's prima facie case⁵ and in support of its claim of acquired distinctiveness is essentially the same.

The examining attorney contends that all questions of fact and law have been determined and that no conditions have changed since the previous ruling. Applicant argues that the res judicata argument is untimely, having been raised for the first time in the examining attorney's brief when, as applicant points out, it could have been raised at the time of the examining attorney's denial of applicant's (second) request for reconsideration.

Apart from the question of whether the res judicata argument was timely raised by the examining attorney, we find that the principles of the doctrine do not apply in this case. It is generally held that an applicant is not precluded by an adverse judicial determination of its right to registration in an ex parte proceeding from seeking registration in a second application if the applicant can show that facts or circumstances have changed since the rendering of the adverse

⁵ Notwithstanding the prior decision, applicant maintains in the present appeal that the examining attorney has not met her initial burden of showing that the mark is generic.

final decision in the first application. See, for example, *In re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988); and *In re Oscar Meyer & Co., Inc.*, 171 USPQ 571 (TTAB 1971). See also *In re Bose Corp.*, 476 F.3d 1331, 81 USPQ2d 1748 (Fed. Cir. 2007) citing *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1314 (Fed. Cir. 2005) ("We have warned that particular 'caution is warranted in the application of preclusion by the PTO, for the purposes of administrative trademark procedures include protecting both the consumer public and the purveyors.'").

Under the circumstances, and in an exercise of caution, we find that the survey evidence constitutes a change in facts sufficient to avoid application of the doctrine of res judicata and to justify re-examining applicant's claim that the term HOTELS.COM is not generic. See, e.g., *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1411 (TTAB 1988) (prior Board decision finding LA YOGURT for yogurt incapable of distinguishing source did not preclude registration of LA YOGURT under the doctrine of stare decisis;⁶ application of the doctrine "would be inappropriate in view of the prima facie showing by applicant of changed facts and/or circumstances" based on newly submitted evidence of consumer letters and a survey dealing with purchaser perception

⁶ In the context of this ex parte proceeding, we consider a res judicata argument to be equivalent to a stare decisis argument.

of LA YOGURT). The probative value of the survey evidence in this case will be weighed along with all the other evidence of record.

We turn then to a consideration of the present appeal. To the extent the evidence is the same in this case as it was in the prior case, we follow this panel's reasoning and findings as to that evidence, and where applicable, we will cite to the decisions as *Hotels.com I* or *Hotels.com I Recon.*, as appropriate. We will make separate findings as to the evidence that differs. Our ultimate determination, however, will be based on the record before us as a whole.

Procedural Matter

The examining attorney attached a number of dictionary entries from online sources to her appeal brief and requested that the Board take judicial notice of this evidence. (Brief at 8.) Applicant has objected to this evidence as untimely.

The Board may take judicial notice of dictionaries, including online dictionaries, which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). From our review of the attachments, only one of the resources clearly meets that requirement, namely The American Heritage Dictionary of the

English Language (Fourth Edition, 2000), with entries for "hotel" and ".com," retrieved from the bartleby.com website. We take judicial notice of this resource. As to the remaining entries, applicant's objection is well taken and such evidence has not been considered.

Issue on appeal

Applicant states in its brief that it does not dispute the descriptiveness refusal, but believes that the record supports its position that the mark has acquired distinctiveness under Section 2(f) of the Act. (Brief at 1, footnote 1; Reply Brief at 2.) While maintaining that the mark is generic and that no amount of 2(f) evidence can rescue it, as a result of the prior decision the examining attorney, in her brief, has essentially withdrawn the refusal to accept applicant's evidence of acquired distinctiveness if it is ultimately determined that the mark is not generic. (Brief at 6.) Thus, the sole issue on appeal is whether the mark is generic.

Genericness

The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? See *In re Reed Elsevier Properties Inc.*, 482 F.3d

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1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (quoting *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)).

The Office has the burden of proving genericness by "clear evidence" of the public's understanding thereof. In *re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

1. *The genus of applicant's services and the relevant public for the services*

As determined in the prior decision, and as set forth in applicant's brief, the genus of services is the wording used in the recitation, "providing information for others about temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network." Applicant's Brief at 9; *Hotels.com I* at 22-23.

The Board found in the prior case, and there is no dispute here, that the relevant public for applicant's services consists of "all customary consumers of the services, including those who would need information on hotels and other forms of temporary lodging, or would need to book or make reservations for the same, for business or leisure needs, as an alternative residence during construction or renovation of a primary residence, for

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conferences or special events, or for any other reason."

Hotels.com I at 23.

2. *The meaning of HOTELS.COM to the relevant public*

Evidence of the relevant public's understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. See *Reed Elsevier Properties Inc.*, supra at 1380; and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). We have considered all the evidence of record bearing on purchaser perception of HOTELS.COM, including the evidence applicant has submitted in support of its claim of acquired distinctiveness. See *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997); and *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988).

The examining attorney has submitted listings from The American Heritage Dictionary of the English Language (Third Edition 1992 and Fourth edition 2000) defining "hotel" as "An establishment that provides **lodging** and usually meals and other services for travelers and other paying guests." (Emphasis added.) The genus of applicant's services involves information about temporary lodging and making reservations for temporary lodging. There is no question, and moreover the evidence submitted by the examining attorney shows, that "temporary lodging" is the equivalent of or includes "hotels." See, for

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example, the website printouts from www.wa.gov ("Hotels and Lodging ... National Industry at a Glance..."), stating that "Hotels and other lodging are homes away from home for business travelers and vacationers, offering both temporary lodging and relief from housekeeping chores back home ..."; and www.austin.about.com, referring to "Austin Hotels, B&Bs, Resorts and Other Temporary Lodging."

Also of record are printouts of various pages from applicant's website, www.hotels.com, and advertisements promoting both applicant's website and the services available on that website. The website's home page includes a tab for linking to "Hotels," to search for lodging information and/or to book a reservation, with additional tabs to search for hotel information "by city" or "by amenity" or "by address." Applicant's print advertisements directing the public to its website variously state: "Book online at www.hotels.com"; "hotels.com enables you to quickly and efficiently compare accommodations by: price, quality, Location...Amenities, Availability..."; and "Use this coupon and save on your next hotel reservation with hotels.com." The examining attorney also points to one of the questions asked in an online market survey that visitors to applicant's website were asked to complete: "Please list any travel or hotel sites other than hotels.com, which you frequent."

It is clear from applicant's website and other promotional materials that "hotels" are the focus, or a key focus, of the information about temporary lodging and reservations for temporary lodging that applicant provides on its website. Because the term HOTELS names a key aspect of applicant's services, i.e., that aspect of applicant's information services and reservation services that deal with hotels, the term is generic, at least for those aspects of applicant's services.

The term HOTELS.COM is no more registrable than the generic word "hotels," alone. The examining attorney has submitted an entry from The American Heritage Dictionary of the English Language (Fourth Edition 2000) defining ".com" as "ABBREVIATION: commercial organization (in Internet addresses)." We also take judicial notice of the following definition of "TLD" as "(Top-Level-Domain) The highest level domain category in the Internet domain naming system. There are two types: the **generic** top-level domains, such as .com, .org, and .net... ." McGraw Hill Computer Desktop Encyclopedia (9th ed. 2001) (emphasis added). The term ".COM," in itself, has no source-indicating significance. Rather, it signifies that the user of the domain name is a commercial entity, and that the goods or services offered by the entity involve use of the Internet. See *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004).

Furthermore, there is nothing in the combination of HOTELS and .COM that results in any new or incongruous meaning, or a different commercial impression. While there is no bright-line rule that appending a top-level domain name such as ".com" to an otherwise generic term will never affect registrability (see *Oppedahl*, supra), in this case it does not. Each of the terms HOTELS and .COM has a clear and readily understood meaning and the combined term communicates just as clearly and directly that applicant operates a commercial website that provides its customers with information about hotels. The Federal Circuit has held that "the PTO has satisfied its evidentiary burden [on genericness] if...it produces evidence including dictionary definitions that the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

The examining attorney has also made of record printouts of Google search summaries, together with printouts from some associated websites.⁷ It can be seen from the web pages and even from the more abbreviated excerpts in the search summaries that the term "hotel.com" or "hotels.com" is frequently used as part

⁷ Although some of the websites are referenced only in summary format, we find that there is ample information in the summary to understand the context of usage. Cf. *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) ("probative value of search engine summary results...will vary depending upon the facts of a particular case.").

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of the domain names of others to denote websites that provide hotel information and/or hotel reservation services, i.e., the services provided by applicant's website. Examples of these websites are shown below:

Hotels, travel, discount hotels - reservations and lodgings
Hotels and hotel reservations by All-Hotels, travel, lodgings and discount hotels worldwide. Instant reservations at 10000 hotels in 10000 locations. ... All-Hotels is one of the largest online hotel reservation companies - we have every kind of lodging...all over the world! [Printed at bottom of web page.]
www.all-hotels.com

hotel reservations and bookings
...Web-Hotels.com - Travel and Hotel Reservations. Hotel booking for all major worldwide cities and travel destinations. ... [The web page also includes tabs to search for "value rates" and "premiere hotels."]
www.web-hotels.com

My-Discount-hotels.com
...
My-discount-hotels.com is one of the most active online discount hotel reservation websites. ... My-discount-hotels.com is one of the most visited hotel information sites on the internet.
www.my-discount-hotels.com

Hotel Reservation Site
Free - compare rates and prices for hotel reservation sites. ...
www.123-hotels.com

Additional examples of such usage include

www.choicehotel.com ("...Book and Save now with Best Choice e-rate Guarantee"); and **www.dealsonhotels.com** ("Find a Lower Rate,

We'll Beat It! Low Internet Hotel Rates Guaranteed").⁸

It is clear from the website and promotional materials of applicant as well as the websites of third-parties that consumers who are interested in finding information about hotels or making reservations at hotels, would immediately understand that HOTELS.COM identifies a website that provides such services. Cf. Reed Elsevier Properties Inc., supra at 1381 (affirming the Board's finding that LAWYERS.COM is generic for online information exchange in the fields of law, legal news, and legal services, the Court noted that third-party websites are competent sources to determine what the relevant public would understand LAWYERS.COM to mean and provide substantial evidence to support the Board's decision). In addition, this evidence demonstrates a competitive need for others to use as part of their own domain names and trademarks, the term that applicant is attempting to register.

HOTELS.COM is properly considered a compound word for purposes of the genericness analysis rather than a phrase, as the two terms appear without any space or separation between them. See In re Gould, supra; and, e.g., In re

⁸ There are also a number of websites for hotel information or hotel reservations that include the term "hotel" somewhere in the name, including www.hotelstravel.com ("Containing over 75000 links to hotels, discount hotels and travel-related services, the most complete, comprehensive and up-to-date hotel directory on the web...."); and www.hotelres.com ("Online hotel reservations, discounted rates, best value rating system and objective hotel information for hotels in San Francisco.").

CyberFinancial.Net Inc., *supra*. Compare *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). However, even if HOTELS.COM were viewed as a phrase, under the analysis required by *American Fertility*, we would still find it generic. The evidence showing use of domain names incorporating "hotel.com" or "hotels.com" by others in the field to refer to the same types of services as those defined in the application reflects a clear understanding of the phrase HOTELS.COM, as a whole, as it relates to the genus of applicant's services. See *Marvin Ginn*, *supra* at 530. (the "critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question."). Compare *American Fertility*, *supra* at 1837 ("The PTO here failed to provide any evidence that the phrase as a whole, SOCIETY FOR REPRODUCTIVE MEDICINE, has acquired no additional meaning to the relevant public than the terms 'society' and 'reproductive medicine' have individually.")

Furthermore, it can be seen from some of the above excerpts, i.e., www.all-hotels.com, www.my-discount-hotels.com, and www.123-hotels.com, that websites providing information about hotels and reservations for hotels, are referred to as "hotel information sites" and "hotel reservation sites." See also, for example, www.hotres.com ("In contrast to other hotel

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reservation websites, you can complete an entire reservation with HOTRES.com..."); and www.phi-phi.com ("Unlike many hotel reservation websites, phi-phi.com only requires your credit card details after you have received your Reservation Confirmation"). In addition, the website, www.travelscience.com, provides links to other "hotel information and reservation sites" such as hotelrooms.com ("This is one of the best hotel sites we have found. They have a...terrific hotel search engine..."); and hotelstravel.com ("This site has over 75,000 links to a worldwide selection of hotels..."). Similarly, the website www.travel-channel.us provides "Lodging and Hotel Information Sites" and "Best Hotel Information Sites" ("Our websites offer the information you need for planning the perfect family vacations...").

It is clear from this evidence that "hotel information site" or "hotel reservation site" identifies a particular type of website. The genus of applicant's services, which is defined as providing information about temporary lodging and making reservations at temporary lodging, logically includes the type of website known as a "hotel information site" or a "hotel reservation site." Thus, HOTELS.COM is generic for an additional reason. It not only identifies a central focus of applicant's services, as discussed earlier, but it also identifies at least one category of the services themselves,

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i.e., that applicant provides a hotel information website and a hotel reservation website. "So long as [the mark] is generic for one of the recited services, it must be refused registration. It need not be shown to be generic for each of the recited services." In re Eddie Z's Blinds and Drapery Inc., 74 USPQ2d 1037, 1042 (TTAB 2005). It is also clear from this evidence that domain names incorporating "hotel.com" or "hotels.com" are used by others to identify such websites. Consumers would see HOTELS.COM and they would immediately recognize it as a term that denotes a hotel information website and/or a hotel reservation website.

Applicant argues essentially that HOTELS.COM is not generic because applicant is not providing a "hotel" service as it does not provide lodging and meals for its users; and that based on definitions for "agency"; "hotel"; "reservation" and "reserve" from Random House Webster's College Thesaurus the term "hotel" is not a synonym for any of those terms. (Response dated August 4, 2004 at 4.)

The Federal Circuit rejected a similar argument by the applicant in Reed Elsevier Properties Inc., supra. In that case, as noted earlier, LAWYERS.COM was found to be generic for online information exchange in the fields of law, legal news, and legal services. Although applicant argued that it was not seeking to register its mark for selling lawyers or offering

services of lawyers, the Court found that the Board properly concluded that "a central and inextricably intertwined element of [the claimed] genus is information about lawyers and information from lawyers." Reed Elsevier Properties Inc., *supra* at 1380. Similarly, in the present case, "hotels" identifies the central focus of the information and reservation services provided on applicant's website, and thus the term HOTELS.COM, consisting of nothing more than a term that names that central focus of the services, is generic for the services themselves. See also, for example, *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1441 (TTAB 2005) (SPORTSBETTING.COM generic for, *inter alia*, provision of information regarding sports and betting, finding that "the information piece of applicant's recited services is inextricably tied into the actual betting."); and *In re CyberFinancial.Net Inc.*, *supra* (BONDS.COM generic for Internet information services and electronic commerce services which are directed, in part, to bonds, the products which comprise the subject matter of applicant's services).

Further, as to this point, this panel noted in the prior decision that *In re Seats, Inc.*, 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985) was distinguishable from the prior case; and we again find it distinguishable from the present case. The *Seats* case involved an application to register SEATS as a mark for "ticket reservation and issuing services for various events by

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means of a computer," and the Federal Circuit stated: "The term 'seats' may be generic in relation to chairs or couches or bleachers. It is clearly not generic to reservations services. Contrary to the Board's statements Seats is not selling seats, as would for example a furniture merchant, but is selling a reservation service... ." Id. at 367-68. However, as this panel explained in the prior case:

Just as Seats, Inc. was not selling seats, applicant here is not selling hotels, or even providing hotel services, but it is there that the similarity with the Seats case ends. Though the Federal Circuit noted the Board's concern with "a need of others to use SEATS in describing the present services," there is no indication in the Seats decision that the Board actually had before it evidence of use of the term by other purveyors of ticket reservation and issuance services. In contrast, the record in this case evidences use of "hotel.com" and "hotels.com" as part of the domain names of third-party web sites; and those web sites appear to provide information to prospective users of hotels that is the same as or very similar to that provided by applicant's web site. In short, this case does not involve a perceived need for others to use a term, but involves a demonstrated use of the term by others. The relevant public will, therefore, perceive use of "hotels.com" as indicating a web site focused on hotels and, specifically, providing information about hotels and the possibility of reserving a hotel room.

Hotels.com I at 31-32.

This case is also distinguishable from *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). In that case the Federal Circuit reversed the Board's holding affirming the genericness refusal to register 1-888-MATRESS as a mark for "telephone shop-at-home services in

the field of mattresses." We recognize that there are similarities between a telephone number and a domain name in that each typically can be used by only one entity at a time. However, as explained in *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB June 11, 2002) and *In re CyberFinancial.Net*, *supra*, although telephone numbers are unique, i.e., a given ten-digit number can be used by only one entity at a time, domain names may be up to sixty-three numbers or characters (plus the characters used to identify the TLD), so that many domain names could contain the same root terms (such as "hotels.com"), combining them with different numbers or letters as prefixes and/or suffixes.

We find here, as in the prior case, that the examining attorney has met her burden of establishing, *prima facie*, that the primary meaning of HOTELS.COM is generic for the involved services. In addition, we find that applicant's evidence does not rebut this showing of genericness.

In support of applicant's contention that HOTELS.COM is not generic, applicant has submitted printouts of a number of third-party registrations for marks that include either the word HOTEL(S) or the term .COM, and in a few instances, marks that include both terms. Applicant argues that the USPTO has permitted marks allegedly similar to applicant's mark to register either on the Supplemental Register or on the Principal

Register, with or in some cases without a showing of acquired distinctiveness.

For the most part, these marks are readily distinguishable from the mark herein and they do not compel a finding that applicant's mark is not generic. In any event, regardless of what these third-party registrations may show, and even to the extent the marks in these registrations "have some characteristics similar" to the mark herein, as the Federal Circuit has stated, "the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). It is well settled that each case must be decided on its own facts, based on the particular mark, the particular goods or services, and the particular record in each application. Accordingly, there is "little persuasive value in the registrations" applicant has submitted. Id. Nor do these third-party registrations establish that there is an Office practice holding such marks are generally registrable. See In re First Draft, Inc., 76 USPQ2d 1183 (TTAB 2005).

Applicant also argues that applicant's evidence demonstrates that HOTELS.COM is perceived as a non-generic brand name by a large majority of the relevant class of purchasers for applicant's services. To support this contention, applicant made of record in this case, as it did in the prior case, 64

declarations, identifying the declarants as "Applicant's customers, vendors, competitors and others in the field."

(Brief at 9.) Applicant maintains that this evidence shows both acquired distinctiveness of HOTELS.COM and that the term is not generic. This evidence was thoroughly considered and discussed by this panel in the prior decision, and without repeating the findings of the prior decision, we adopt them here. See, generally, *Hotels.com I Recon*. Further, we adhere to this panel's conclusion in the prior case that the declarations are not entitled to significant probative value in determining how the relevant public perceives the term "hotels.com." *Id* at 10.

We have also considered applicant's other evidence of acquired distinctiveness in determining the relevant public's perception of the mark. Applicant has submitted the declaration of Elizabeth Hart, a (now former) paralegal of applicant's counsel, introducing evidence of use of the essentially equivalent HOTEL.COM mark since 1997. Applicant has also submitted the declaration of Linda Essary, applicant's compliance manager, attesting to applicant's substantial revenues and advertising expenditures, and introducing examples of print and other forms of advertisements and other evidence of extensive public exposure of HOTELS.COM. However, evidence of even significant promotion, use and sales cannot transform a generic term into a trademark. See *Roux Laboratories, Inc. v.*

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Clairol Inc., 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970) ("mere advertising or other evidence of supposed secondary meaning cannot convert something unregistrable by reason of its being the common descriptive name or generic name for the goods - the antithesis of a trademark - into a registrable mark"); and In re Northland Aluminum Prods., Inc., 777 F.2d 1556, 227 USPQ 961, 964 (Fed. Cir. 1985) (BUNDT common descriptive name for type of cake and evidence of de facto secondary meaning cannot change that result). See also *Hotels.com I* at 32, 35.

Also attached to the Essary declaration is the online market study mentioned earlier which was conducted on applicant's hotels.com website. While the study may demonstrate consumers' favorable view of the website, the services provided on the website and various advertisements relating to the website, the study does not, as applicant claims, evidence consumer perception or recognition of HOTELS.COM as a mark.

We turn finally to applicant's survey. This was a national probability double blind telephone survey conducted by Thomas D. Dupont, Ph.D. using a "Teflon" format.⁹ The survey sample consisted of 277 males and females age 18 and over who have stayed at a hotel or motel in the past 12 months or plan to in

⁹ Applicant describes the survey as a "'Teflon' type" survey. This refers to the format of the survey used in *E.I. duPont De Nemours & Co. v. Yoshida International, Inc.*, 393 F.Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975) to prove that "Teflon" was not generic.

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the next 12 months. (Survey report at 2 and 6.) The stated objective of the survey was to determine whether consumers perceive HOTELS.COM as a brand name or as a generic (common) name for the services.

Respondents were first told the difference between a brand name and a common name using three examples, as illustrated by the following: "For a business that sells gasoline, SHELL would be a brand name and SERVICE STATION would be a common name." The respondents were then tested for their understanding of the concepts by asking two additional questions, one of which was: "For a business that sells HAIRCUTS, would you say BARBER SHOP is a BRAND NAME or a COMMON NAME?" The 27 respondents who did not answer both questions correctly were eliminated from the survey.

The remaining 250 respondents were asked a series of questions presented in a standard format and in "randomized order" about the names of eight retail businesses, including HOTELS.COM. The following are representative of the questions presented:

For a business that sells FLOWERS, would you say FLORIST is a BRAND NAME or a COMMON NAME?

For a business that makes HOTEL RESERVATIONS AND PROVIDES INFORMATION ABOUT HOTELS, would you say HOTELS DOT COM is a BRAND NAME or a COMMON NAME?

The results of the survey are displayed in "Table 1" below.

Table 1
Perceptions of Whether Name is Brand Name Or Common Name
(Base = 250 Respondents)

	<u>Brand</u>	<u>Common</u>	<u>Other</u>	<u>Don't Know</u>
	<u>%</u>	<u>%</u>	<u>%</u>	<u>%</u>
TOYS R US	95	4	-	1
DAIRY QUEEN	92	6	*	1
AMAZON.COM	87	8	-	4
HOTELS.COM	76	20	-	4
SEARCH ENGINE	15	74	-	11
NAIL SALON	11	84	-	5
FLORIST	6	93	-	1

* Less than 0.5%

As can be seen in the table, 76% of the respondents answered that HOTELS.COM is a brand name. While that figure seems impressive on its face, we find that the survey is so seriously flawed that the results cannot be given any weight.

To begin with, there was a critical omission in the screening process and the result is that the universe for the survey is fatally overbroad. Dr. Dupont screened for respondents' understanding of the difference in concept between a brand name and a generic name. However, the term involved in this case also happens to be a domain name. Although we can assume that consumers will recognize HOTELS.COM as a domain name, we cannot assume that they understand the conceptual

difference between a domain name and a brand name, or even recognize that there is a difference. Many consumers may automatically equate a domain name with a brand name, believing they both serve the same function. Thus, Dr. Dupont should have ascertained through the screening process, rather than assumed, that participants in the survey could distinguish the two concepts; and those who could not make the distinction should have been eliminated from the sample. As it stands, this universe of respondents could have viewed any ".com" name, regardless of the nature of the term preceding it as a so-called brand name, thereby radically skewing the results of the survey in applicant's favor.

At a minimum, the respondents should have been presented with sample names that had some relevance to the mark in this case. Except for the term AMAZON.COM, which involves a compound term created by joining an arbitrary term and a TLD, the sample names have no connection to the type of mark at issue. Furthermore, the name AMAZON.COM is too obvious an example of a ".com" domain name that also functions as a brand name. The survey should have tested for respondent understanding of various types of compound terms using ".com," including compounds utilizing a generic term and ".com." Then results showing recognition of such terms as generic would have made the 76% who recognized HOTELS.COM as a brand name meaningful.

Finally, we note that the survey report states that the questions were asked in randomized order. This was apparently accomplished by a computer, but there is no indication of whether or how frequently the HOTELS.COM mark was immediately preceded by the well recognized example of a ".com" brand name, AMAZON.COM. If HOTELS.COM was preceded in the line-up of questions by this name, it could have led or misled respondents into automatically assuming that they should consider HOTELS.COM a brand name as well.

In light of the noted deficiencies in the survey, we find that it is entitled to no probative weight as to public perception of HOTELS.COM.

While we acknowledge, as applicant points out, that any doubt on the question of genericness must be resolved in favor of publishing the mark for opposition, we disagree with applicant that its evidence is sufficient to raise any such doubt about the genericness of HOTELS.COM. For the reasons set forth in the prior Board decisions, and for the additional reasons expressed herein, we find that HOTELS.COM is generic, and that the record in this case does not dictate a different result.

Acquired distinctiveness

Although we have determined that HOTELS.COM is generic, as mentioned earlier, if applicant should ultimately prevail in any appeal of this decision, we find in the alternative that the

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evidence of acquired distinctiveness is sufficient to support registration under Section 2(f).

Decision: The refusal to register under Section 2(e)(1) is affirmed.



HOTEL-I.pdf



HOTEL-recon
.pdf

Hearing:
January 31, 2006

**This Opinion is Not
Citable as Precedent
of the TTAB**

Mailed:
September 11, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hotels.com, L.P.

Serial No. 76414272

Gary D. Krugman, Kevin G. Smith and Jody H. Drake of
Sughrue Mion PLLC for Hotels.com, L.P.¹

Ingrid C. Eulin, Trademark Examining Attorney, Law Office
111 (Craig D. Taylor, Managing Attorney).

Before Walters, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Hotels.com, L.P., a limited partnership of Texas,
filed an application on May 30, 2002 to register the
proposed mark set forth below for services identified as
"providing information for others about transportation;
travel agency services, namely, making reservations and
bookings for transportation for others by means of

¹ The attorneys from the Sughrue law firm assumed responsibility
for the application following issuance of the examining
attorney's final refusal to register the proposed mark.

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telephone and the global computer network," in Class 39;
and for "providing information for others about hotel
reservations and temporary lodging; travel agency services,
namely, making reservations and bookings for temporary
lodging for others by means of telephone and the global
computer network," in Class 43.



When filed, the application stated applicant's
intention to use the proposed mark in commerce for the
respective services in each class. It is clear from the
record, however, that the proposed mark was already in use
for both classes of services. In fact, when responding to
the examining attorney's initial office action, applicant
asserted that it began using the proposed mark "following
the launch of Applicant's hotels.com website on March 25,
2002." Resp. of March 25, 2003.

The examining attorney's first two office actions
included certain requirements for amendment of the mark
drawing included with the original application. Applicant
has complied with those requirements and the quality of the

drawing is no longer in issue. In contrast, with the third office action, the examining attorney made final a requirement advanced in the initial action and continued in the second action, specifically, a requirement that applicant include a disclaimer of exclusive rights in the term "hotels.com."

The examining attorney contends that "hotels.com" is generic for applicant's Class 43 services. Accordingly, the examining attorney refused to accept applicant's claim, made in response to the first and second office actions, that "hotels.com" has acquired distinctiveness as a mark and therefore need not be disclaimed. The third office action also made final the refusal to accept the evidence of acquired distinctiveness. We note that applicant's proffer of such evidence was, in fact, premature. Even though the record is clear that the mark was in use when the application was filed, the application was, throughout the referenced exchange of office actions and responses, based on intent to use. A claim of acquired distinctiveness usually can only be made in regard to an application based on use or amended to claim actual use of the mark in commerce.

The question whether the proposed mark has acquired distinctiveness is, however, an issue in this appeal. The

examining attorney considered the evidence submitted in responses to the first and second office actions and addressed it. Further, three months after the final refusal, applicant filed an amendment to allege use; and prior to expiration of the appeal period, applicant filed a request for reconsideration containing additional arguments on the issue of acquired distinctiveness. When the examining attorney subsequently issued an office action on applicant's request for reconsideration, the action did not assert any insufficiency in the amendment to allege use. We take the examining attorney's silence on the matter as indicating the amendment to allege use was acceptable in all respects. Therefore, because the application before us has been acceptably amended to assert use of the mark in commerce, and because the examining attorney has not objected to any of the proffered evidence of acquired distinctiveness, we have considered all such evidence as properly of record.

Applicant included with the amendment to allege use a request that the application be divided, because the examining attorney's assertion of genericness had been stated to apply only to the Class 43 services. By the request to divide, applicant sought to have the proposed mark be freed for registration for its Class 39 services.

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The request to divide was promptly processed and the application was divided, with the Class 39 services covered by the newly created application and the Class 43 services remaining in the application that is the subject of this appeal.

The proposed mark eventually was registered for applicant's Class 39 services and applicant, in the involved application, has included a claim of ownership of that registration (Reg. No. 2918738). Applicant has also included a claim of ownership of Reg. No. 2793744 for the mark 1 800 USA HOTELS.COM, in standard character or typed form. This other mark is registered for "Discount travel agency services, namely, making reservations and bookings for transportation," in Class 39, as well as for "Discount travel agency services, namely, making reservations and booking for temporary lodging," in Class 43. Reg. No. 2918738 is registered on the Principal Register without any disclaimer or resort to Section 2(f); Reg. No. 2793744 is registered under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), i.e., on a claim of acquired distinctiveness of the mark 1 800 USA HOTELS.COM.

Applicant timely filed a notice of appeal from the examining attorney's refusal to register the proposed mark for applicant's Class 43 services and, as noted above, also

filed a request for reconsideration. By its request for reconsideration, applicant amended the identification of services to delete the words "hotel reservations and," so that the resulting identification in Class 43 reads "providing information for others about temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network." The examining attorney acknowledged the amendment in the office action denying the request for reconsideration.

After applicant's request for reconsideration was denied, this appeal was resumed and was fully briefed. Applicant requested a hearing and oral arguments were presented by counsel for applicant and by the examining attorney.²

Applicant's Objection to Evidence

A preliminary matter requiring attention is applicant's objection, set forth in its reply brief, to the evidence attached to the examining attorney's brief. While applicant acknowledges both that the evidence was presented

² In a separate matter, we note that applicant filed a notice of appeal from the refusal of the examining attorney to register HOTELS.COM, in standard character form, for the services at issue in this appeal. At the request of applicant, however, that appeal has been suspended pending disposition of the instant appeal.

by the examining attorney as "dictionary and encyclopedic evidence," and that the Board can take judicial notice of standard reference works, applicant contends that this evidence, besides being untimely, includes many references derived from online sources or web pages and these are "of unknown origin, unknown reputation and unknown accuracy." Reply brief, p. 2, fn 1. We agree that approximately half of the sources offered by the examining attorney to provide definitions of various terms bear no indication that they are available in printed form, or derived from a printed work. In contrast, 11 of the attachments are merely online or web presentations from standard printed reference works.

There are four definitions retrieved from the Merriam-Webster Online Dictionary ("travel agency," "accommodation," "reservation" and "hotel"), and three retrieved from "Bartleby.com" ("accommodation," "hotel" and ".com"), with the Bartleby pages specifically stating that the source of the definitions is The American Heritage Dictionary of the English Language, Fourth Edition (2000). There is also a page retrieved from the Encyclopaedia Britannica Online, which indicates that its definition of "hotel" is "from the full 32 volume encyclopedia"; and there is a page from "AskOxford.com" which features a definition of "hotel" from the printed Compact Oxford

English Dictionary. Finally, there are two pages retrieved from "Cambridge" dictionaries, with one page featuring a definition of "hotel" from the Cambridge Dictionary of American English, while the other page features a definition of ".com" from the Cambridge Advanced Learner's Dictionary; and each of these two web pages notes the source and availability of the printed volumes. We sustain applicant's objection to the majority of the attachments to the examining attorney's brief, but have considered those we have referenced above, because it appears clear that these web page definitions have their origin in printed works and are appropriate items of which to take judicial notice. Cf. In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999) (The Board will not take judicial notice of definitions found only in on-line dictionaries and "not available in a printed format.") (emphasis added).

Other Evidence of Record

Having resolved the question of how to treat the evidence attached to the examining attorney's brief, we now turn to a review of what other evidence is of record. Because the examining attorney has refused registration on the ground that applicant's proposed mark is generic, the evidence on which the examining attorney relies consists of

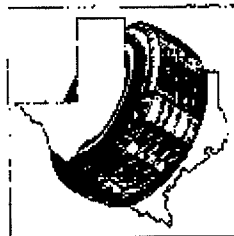
dictionary and encyclopedia definitions, of both "hotels" and ".com," as well as of terms set forth in applicant's identification of services. The examining attorney also relies on some of applicant's evidence of acquired distinctiveness and on applicant's specimens, as support for the contention that "hotels" conveys, to the relevant public, more than just hotel services and can also mean hotel reservation or booking services. Finally, the examining attorney also relies on certain reprints from office records regarding registrations owned by applicant, on reprints of web pages from applicant's web site, and on various other web pages or listings of the results of searches conducted on the web.

Applicant's contributions to the evidentiary record primarily consist of evidence offered in support of its claim that the "hotels.com" portion of the proposed mark, although it may be descriptive (see brief, p. 5), is not generic and has acquired distinctiveness sufficient to allow for registration of the entire mark without the disclaimer required by the examining attorney. Applicant contends that "hotels.com" is not generic, that the mark as a whole is unitary, and that the examining attorney's evidence is insufficient to establish genericness.

Specific consideration of the evidence of genericness and of acquired distinctiveness follows, in conjunction with our discussion of each of those issues. We begin, however, with the question whether applicant's proposed mark is unitary.

Is the Proposed Mark Unitary?

Applicant's first argument in this appeal is that its proposed mark is unitary, because its literal ("hotels.com") and design (the bellman) elements create a single commercial impression and the proposed mark cannot be divided into separable components. Brief, p. 3, citing TMEP Section 1213.05(f) and In re Texsun Tire and Battery Stores, Inc., 229 USPQ 227 (TTAB 1986). The mark in the Texsun Tire case is set forth below:



The inquiry into whether a proposed mark is unitary is a factual determination and "requires the Board to determine 'how the average purchaser would encounter the mark under normal marketing of such goods.'" In re Slokevage, 441 F.3d 957, 78 USPQ2d 1395, 1398 (Fed. Cir.

2006), citing Dena Corp. v. Belvedere Int'l Inc., 950 F.2d 1555, 1561, 21 USPQ2d 1047 (Fed. Cir. 1991) (citations in Dena omitted in Slokevage). Accordingly, while there are many reported decisions of the Federal Circuit and the Board that deal with the question of whether the elements of a proposed mark are unitary or not, they provide little aid in resolving the factual question presented by the case at hand. We do note, however, that the Texsun Tire case on which applicant relies did not deal directly with a requirement by an examining attorney that the applicant in that case disclaim a portion of the composite mark. In fact, prior to the appeal of a substantive refusal of registration, applicant had already disclaimed the design of the tire. Texsun Tire, 229 USPQ at 228. The majority, dealing with the substantive refusal of registration on the ground that the mark was primarily geographically descriptive, found the examining attorney's focus on the map of Texas alone, notwithstanding the disclaimer of the tire design, to be in error and found that the proposed mark was "a unitary composite mark which is unique and fanciful... the mark involved herein is not merely a map but a unique combination of parts which may not be fragmented into its various pieces for purposes of analysis and which,

in the distinctive form presented, competitors have no need to utilize." Id. at 229.

If there is a lesson to be learned from Texsun Tire, it is that we should focus on whether the composite proposed for registration by the instant applicant is "a unique combination of parts," i.e., the focus of the factual inquiry is not on whether the parts themselves are unique, but whether the combination is unique and one that "may not be fragmented." It is only when the elements of the proposed mark form an inseparable whole that the mark is to be considered unitary. Slokevage, 78 USPQ2d at 1399.

In the case at hand, applicant argues that the elements in its proposed mark are unitary because they "are contiguous and actually touch one another." Brief, p. 3. The examining attorney acknowledges that factors that have been considered when determining whether elements in a composite mark are unitary include "whether lines or other design features physically connected the elements, the relevant location of the elements, and the meaning of the terminology as used in connection with the services," and that "in some instances, because of the visual presentation of the design and word(s), the components are considered unitary and not subject to disclaimer." Brief, p. 3. Nonetheless, the examining attorney argues that close

examination of the mark drawing itself reveals that the bellman is actually separated from the term "hotels.com" because "the design element is spatially, slightly forward of the word portion, as if the bellman slightly stepped forward from the wording." Id. The examining attorney also argues that the elements are not merged by any weaving of the design and wording; that, as used on applicant's website, the word portion is presented in red and the design element in black and white, thus distinguishing the two elements; and that the pictorial and literal elements have different connotations. Brief, pp. 3-4.

In its reply brief, applicant argues that any visual separation of the elements that might be attributable to a portrayal of the composite in multiple colors is irrelevant, as applicant has not sought to register the proposed mark with any claim to particular colors. Reply brief, pp. 2-3. We agree with applicant that, because it has not sought to register the proposed mark in any particular colors, if it is registered applicant will be free to use any colors and will not be restricted to the colors presently utilized on its website. Further, as the record makes clear, the proposed mark is often utilized in advertisements that appear in publications in black and white, such as in a newspaper. Nonetheless, because the

Slokevage and Dena decisions state that we must consider "how the average purchaser would encounter the mark under normal marketing," and because representations of the mark in color would be included in normal marketing that would be seen by the average consumer, we do not discount the significance of the differences in color noted by the examining attorney. We add, however, that this is only one piece of evidence to be considered in the factual determination we must make.

The operative identification includes two services, specifically, "providing information for others about temporary lodging" and "travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network." On the record, we must assume that the former service is also provided by means of telephone and the global computer network (i.e., the Internet). There is nothing to indicate that applicant, for example, only publishes information about lodging in magazines or guidebooks. To be clear, the record shows that applicant utilizes many forms of advertising, including magazines or other publications, in "the normal marketing of" its services; and those means of advertising are to be considered in assessing "how the average purchaser would

encounter the [proposed] mark." The fact remains, though, that the services themselves are provided by telephone or via the Internet; and that fact is to be considered in the assessment not of whether the proposed mark is unitary but whether the "hotels.com" portion is descriptive or generic.

Attachments to applicant's December 19, 2003 response to the examining attorney's second office action include numerous advertisements and they almost uniformly show the composite mark proposed for registration, i.e., with no separation between the two elements. The record, however, includes a number of examples of use by applicant of the elements of its composite mark with a clear separation between them or as distinct elements of ads. There is, for example, one reprint of applicant's web page from 2003 that shows the "hotels.com" and bellman elements on same page but with clear space between them.

The declaration of Linda Essary, applicant's Compliance Manager, was submitted with applicant's September 30, 2004 request for reconsideration. Exhibit 1 to the Essary declaration includes numerous advertisements and other promotional pieces that would be seen by the average purchaser of applicant's services. Many of these show the composite mark proposed for registration. In one, however, a photo of an advertisement above the entrance to

Madison Square Garden, a viewer from street level would perceive the term "hotels.com" as more dominant, because of its larger size, and might not be clear as to the nature of the associated figure. Numerous other ads show the elements of the composite presented separately, albeit in the same advertisement; still others show only the "hotels.com" element. For example, one exhibit appears to be both sides of a brochure and one side shows not only the composite mark but also each of the elements used separately. The Greater Miami & The Beaches Visitor Guide lists just the "hotels.com" element. An ad in a publication entitled Nevada Events & Shows, poking fun at the Elvis Presley impersonator phenomenon, uses the two elements of the mark separately, fashioning the bellman with Elvis Presley-like hair adjacent to, but separate from a tagline reading "Hotels.com. Thank you. Thank you very much." A reprint of a web page from "frommers.com" features applicant's composite mark in a link to applicant's web site, but a reprint of a web page from "www.bill-me-later.com" includes the "hotels.com" element in the same stylized script as the involved mark but without the bellman in its link to applicant's web site.

Exhibit 3 to the Essary declaration consists of references in wire reports and news articles about

applicant and its web site. Only one of these shows the composite mark proposed for registration. Another, from the June 27, 2004 issue of the Sheboygan (WI) Press, includes a reprint of a page from applicant's web site, and that page shows the "hotels.com" designation clearly separate from the bellman character.

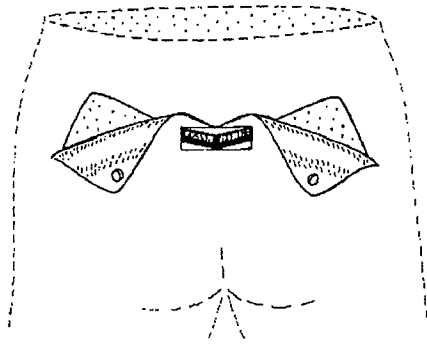
The second declaration submitted with applicant's request for reconsideration is by Elizabeth Hart, a paralegal at applicant's counsel's firm. This was used to introduce the results of Internet searches for archived pages for "hotel.com" and "hotels.com." Numerous pages from the latter search show only use of "hotels.com" without the bellman character.

We find "hotels.com" to be the dominant portion of the composite mark, when viewed from a distance, or when printed in smaller size in an advertisement. In either of these forms of presentation, the bellman figure is less distinct. We also find that applicant has often utilized "hotels.com" and the bellman character as separate elements in its ads. Finally, many consumers exposed to applicant's services through news articles or publications listing applicant's website as one of many providing similar services, will be exposed only to the "hotels.com" element. Consumers exposed to these uses, when subsequently being

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exposed to the composite, will perceive the elements of the composite as presented together but not as inseparable. Likewise, even consumers who are exposed to the composite first, but later see ads showing the separate elements apart, or who are exposed to a listing featuring only "hotels.com" will come to view the elements as related but not unitary.

We also consider, as additional evidence that the proposed mark is not unitary, applicant's pursuit of protection for the individual elements of the composite. See Slokevage, 78 USPQ2d at 1400. In Slokevage, the applicant was seeking registration of trade dress that combined the words FLASH DARE!, a design element and a product configuration (see below), and had separately registered the words on the Principal Register, had obtained a design patent on the flaps configuration, and had registered the flap design as a mark on the Supplemental Register. Notwithstanding that the various elements proposed for registration as a composite mark were all contiguous or touching, the Board found applicant's pursuit of separate registrations for different elements to be evidence the elements were not unitary, and the Federal Circuit affirmed that finding on appeal.



In the case at hand, the record shows that applicant has a separate application pending for the term "hotels.com" and has a separate registration for its bellman design. Thus, we consider this as additional evidence of the non-unitary nature of the elements in the composite mark. We add, however, that, unlike the report of the Slokevage decision, this case includes a good deal of evidence regarding marketplace use of the elements of the composite that is probative of why consumers would perceive the elements of applicant's mark as related but not as unitary or inseparable.

On the evidence of record, we conclude that applicant's proposed mark is not unitary. The mark consists of two readily distinguishable elements - the term "hotels.com" and the bellman design. As shown in the drawing of the mark, the wording appears in a bold solid font, whereas the bellman is rendered in a slight-appearing

line drawing with only his jacket a solid black or other color. The design of the bellman and the wording touch, but just barely; and the bellman appears to be walking away from the words, which, in terms of the overall commercial impression, implies a separateness rather than a merging of the wording and the bellman. This visual impression of separateness is further emphasized for consumers by the extensive evidence, noted above, that the elements, as actually used, often appear separately and, when appearing together, as in the applied-for mark, the wording and bellman design elements are shown in quite different colors. Accordingly, the examining attorney may require disclaimer of the "hotels.com" element if that element is shown to be either generic or descriptive and without acquired distinctiveness.

Is "hotels.com" generic?

1. *The genus of services and relevant public*

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); see also In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir.

1987). The critical issue to determine is whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the genus of goods or services in question. H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 (TTAB 1992).

Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" Ginn, supra, 228 USPQ at 530.

The determination of the genus involved can have an impact on the subsequent determination of what the relevant public considers the proposed mark or portion thereof to mean. Thus, the genus issue may, as in this case, be a subject of disagreement. See, e.g., In re American Institute of Certified Public Accountants, 65 USPQ2d 1972, 1981 (TTAB 2003).

Applicant initially argues that the examining attorney did "not clearly set out" the genus of services and, based on the office action denying applicant's request for reconsideration, may have presumed that "hotel services" is the genus in question. Brief, p. 5. Applicant goes on to

argue that it does not provide hotel services or any lodging services. Id. On the other hand, applicant concedes that its services relate to providing information about lodging and to making reservations and bookings for lodging; and concedes that these services "can in many instances, relate to information about hotels and can relate to reservations and bookings involving hotels." Brief, p. 5. In the end, applicant argues that the relevant class of services is "travel agency services, specifically, travel agency services rendered over the telephone and online." Brief, p. 6; see also, reply brief, p. 3.

In the office's brief, the examining attorney focuses initially on the identification of services and the specimen of use as evidence of what is the genus in this case. Brief, pp. 4-5. However, the examining attorney then goes on to conclude, "The plain meaning of the wording used in the recitation shows that hotel information and hotel reservation/booking services are the identified classes of services at issue." Brief, p. 5.

In this case, however, as in Accountants, we find the recitation of services to be an apt specification of the genus. We do not adopt either the examining attorney's proposed limitation of the genus set out by the

identification, i.e., a limitation that would have us read the identification as if it involved only hotels and not other forms of lodging; but neither do we adopt the applicant's suggestion that the genus is "travel agency services," which is broader than travel agency services restricted to assisting with booking and reservations for temporary lodging, and which also leaves out applicant's information services.

The next question is to determine the relevant class of purchasers for applicant's services. Because there are no restrictions in the identification of services as to channels of trade or classes of consumers, we must assume that the services are available to all customary consumers of the services, including those who would need information on hotels and other forms of temporary lodging, or would need to book or make reservations for the same, for business or leisure needs, as an alternative residence during construction or renovation of a primary residence, for conferences or special events, or for any other reason.

2. *What does hotels.com mean to the relevant public?*

During prosecution of the involved application, applicant deleted the words "hotel reservations" from its identification of services. Applicant has not, however, argued that because of the deletion "hotels.com" cannot be

perceived as generic, and applicant has conceded that hotel information services and reservations/booking services for hotels are encompassed within its identification.³ In essence, applicant has argued that "hotel(s)" would be seen as generic for the relevant public for hotel services but applicant does not provide such services. Accordingly, applicant reasons, "hotels.com" cannot be considered by the relevant public to be generic for the identified services.

Applicant aligns its proposed mark with certain ".COM" (or "dot com") marks that have been found by the Court of Appeals for the Federal Circuit or the Board to be descriptive, and distances its proposed mark from other ".COM" marks the Board has found to be generic. Compare In re Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005) (Court reversed the Board's decision finding

³ In the Board's relatively recent decision of In re Reed Elsevier Properties Inc., 77 USPQ2d 1649 (TTAB 2005), that applicant argued that the proposed mark LAWYERS.COM could not be refused as generic because applicant had deleted the reference to "lawyers" in its identification of services. That applicant also argued that the identification of its "online interactive database featuring information exchange" in certain fields did not include "lawyers" as a field and information on "lawyers" could not be read to be part and parcel of any of the remaining fields. Reed, 77 USPQ2d at 1651. In essence, the applicant in Reed argued that, because the meaning of "lawyers.com" to the relevant public had to be assessed in light of the identified services, and because the identification did not use or encompass the term "lawyers," the proposed mark could not have a generic meaning for the relevant public. The Board rejected that argument and applicant in this case has not made a similar argument.

STEELBUILDING.COM to be generic and found it merely descriptive); In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (Court affirmed Board's finding that PATENTS.COM was descriptive); and In re Microsoft Corp., 68 USPQ2d 1195 (TTAB 2003) (Board found OFFICE.NET to be descriptive); with In re Eddie Z's Blinds and Drapery, Inc., 74 USPQ2d 1037 (TTAB 2005) (Board found BLINDSANDDRAPERY.COM generic); In re CyberFinancial.Net Inc., 65 USPQ2d 1789 (TTAB 2002) (Board found BONDS.COM to be generic); and In re Martin Container, Inc., 65 USPQ2d 1058 (TTAB 2002) (Board found CONTAINER.COM to be generic). Applicant, however, has failed to note that in Oppedahl and Microsoft, the marks were refused only on descriptiveness, not genericness, grounds.

We must focus on the factual inquiry of whether "hotels.com" is understood by the relevant public to refer primarily to the identified services. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See Merrill Lynch, *supra*, 4 USPQ2d at 1143 (Fed. Cir. 1987), and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

"Hotel" is defined as meaning "[a]n establishment that provides lodging and usually meals and other services for travelers and other paying guests." The American Heritage Dictionary of the English Language (4th ed. 2000) (as posted at the Bartleby.com website). Other dictionary definitions of the term of record are similar. A more prosaic definition also serves well: "hotel ... a building where you pay to have a room to sleep in." Cambridge Dictionary of American English.

".Com" is defined as "abbreviation: commercial organization (in Internet addresses)," The American Heritage Dictionary of the English Language (4th ed. 2000) (as posted at the Bartleby.com website). We also take judicial notice of the following definition of "TLD":
"(Top-Level-Domain) The highest level domain category in the Internet domain naming system. There are two types: the generic top-level domains, such as .com, .org, and .net...."
McGraw Hill Computer Desktop Encyclopedia 977 (9th ed. 2001) (emphasis added).

The examining attorney also relies on reprints of the results of three Internet searches. One, conducted on the NexTag website, includes links to "HotelSale.com," "HotelClub.com," "**OnlineHotels.com**" and under "Additional Resources" are the full web addresses for

www.hotellocators.com and **www.TheDiscountHotel.com**. The second search, conducted on www.lodging.net, includes links to "hotels.com" (which we presume to be applicant), "**www.choicehotels.com**," "www.discounthotels.cc," "www.hotellocators.com," and "**al-discount-hotels.com**." And the third search, conducted on Google, retrieved links to "www.hotels.net" (under the heading "Hotel Reservations"), "www.hotellinks.com" (under the heading "Hotels Search Engine") and another listing of "**www.choicehotels.com**." See Office action of May 3, 2005 denying applicant's request for reconsideration (bold emphasis added).

The examining attorney also has noted the manner of use of the term "hotel(s)" on applicant's website, specifically noting that applicant uses the term "hotels" as the designation for a tab that will access lodging information;⁴ that applicant uses the designations "find a hotel," "hotel + air = save," "hotel + air + car = save," "hotels by amenities," and "hotels near an address" as other tabs on the web page. Brief, pp. 4-5. At the top of the web page are also the proposed mark and the designation "Welcome to hotels.com." Attachment to May 3, 2005 office action denying request for reconsideration. Also

⁴ There is also a tab for accessing information on "suites, condos, bed & breakfast."

significant, in the examining attorney's view, are applicant's reprint from its November 1999 website, proclaiming the site to be the "#1 hotel finder," and a question posed in a survey that web site visitors are asked to complete, which asks, survey respondents to "Please list any travel or hotel sites other than hotels.com, which you frequent." See, respectively, exhibit D to the declaration of Elizabeth Hart and exhibit 4 to the declaration of Linda Essary.

The examining attorney argues that this evidence establishes that the relevant public will not only perceive "hotels" as generic for a business providing hotel services, but also as generic for a hotel finder or hotel reservations site, i.e., for a provider of the services at issue in this case. Given that "hotels" is generic for the involved services, the examining attorney concludes that the addition of ".com," to form the compound "hotels.com" is likewise generic, because the ".com" portion is equally generic and merely designates a commercial enterprise doing business on the Internet. In essence, the examining attorney is arguing that the relevant public will, when considering the term "hotels.com" think of it as an answer to the question "what am I?" (a hotel information and reservations site on the Internet) rather than as an answer

to the question "who am I?" (a particular source of hotel information and hotel booking/reservations services).⁵ In this regard the examining attorney relies on In re Gould Paper Corp., supra, for the proposition that the compound term created when two terms are united may be just as generic as the individual terms, if the joined terms retain their separate meanings. Brief, p. 5.

Applicant, in its March 25, 2003 response to an office action, argued that it owns a domain name for "hotels.com" (in addition to "hotel.com"), and "[b]ecause no two entities can register the same domain name, each individual domain name, when considered in its entirety, is unique." The Board has rejected this argument, however, because it is possible that numerous entities could use a term such as "hotels.com" or "container.com," by adding a distinguishing prefix. See Martin Container, supra, 65 USPQ2d at 1061.

Applicant also argues that this case is akin to the Steelbuilding.com case, supra, in that the addition of the TLD ".com" to "hotels" expands the meaning of hotels, and

⁵ As applicant observed in its December 19, 2003 response to an office action, "generic designations answer the question 'What am I?'" See also, 2 McCarthy on Trademarks and Unfair Competition § 12:1 (4th ed. database updated June 2006) ("A mark answers the buyer's questions 'Who are you? Where do you come from?' 'Who vouches for you?' But the name of the product answers the question 'What are you?'").

does not merely form a compound that conveys the meanings of the separate terms. In support of this argument, applicant notes that the applicant in Steelbuilding.com was observed by the Federal Circuit to be using its mark for more than just steel buildings and was using it for a service that allowed web site visitors to design or build their own steel buildings and then calculate the appropriate price before ordering. Reply brief, p. 4. In this case, applicant asserts, its "services go beyond simply providing information about and assisting customers with reservations and bookings of hotel rooms. Applicant's information and travel agency services also relate to other types of non-hotel lodgings, including condos, vacation homes, bed and breakfasts, spas, etc." Id. at pp. 4-5. Applicant's argument, however, is misplaced. In essence, applicant is arguing that "hotels.com" cannot be generic for services that provide information on, or facilitate booking of reservations for, a wider array of lodging than hotels. However, if the term is generic for that aspect of applicant's services that deals with hotels, then it does not matter that it arguably might not be generic for services that deal with condos, spas or other types of lodging. See In re Analog Devices, Inc., 6 USPQ2d 1808 (TTAB 1988), *aff'd in a decision marked not citable as*

precedent, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); see also Eddie Z's, supra, 74 USPQ2d at 1042 ("So long as BLINDSANDDRAPERY.COM is generic for one of the recited services, it must be refused registration. It need not be shown to be generic for each of the recited services."). In addition, while in the Steelbuilding.com case "steelbuilding" could be viewed as referring to either a building of steel or the designing and building of a steel building, there is no such dual meaning that can be applied to the term "hotels.com."

Reference to the decision of In re Seats, Inc., 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985), is also helpful in assessing the case at hand. The Seats case involved an application to register SEATS as a mark for "ticket reservation and issuing services for various events by means of a computer," and the Federal Circuit stated: "The term 'seats' may be generic in relation to chairs or couches or bleachers. It is clearly not generic to reservation services. Contrary to the Board's statements, Seats is not selling seats, as would for example a furniture merchant, but is selling a reservation service...." Id. at 367-68. Just as Seats, Inc. was not selling seats, applicant here is not selling hotels, or even providing hotel services, but it is there that the similarity with

the Seats case ends. Though the Federal Circuit noted the Board's concern with "a need of others to use SEATS in describing the present services," there is no indication in the Seats decision that the Board actually had before it evidence of use of the term by other purveyors of ticket reservation and issuance services. In contrast, the record in this case evidences use of "hotel.com" and "hotels.com" as part of the domain names of third-party web sites; and those web sites appear to provide information to prospective users of hotels that is the same as or very similar to that provided by applicant's web site. In short, this case does not involve a perceived need for others to use a term, but involves a demonstrated use of the term by others. The relevant public will, therefore, perceive use of "hotels.com" as indicating a web site focused on hotels and, specifically, providing information about hotels and the possibility of reserving a hotel room.

We find that "hotels.com" is a generic term and the requirement that it be disclaimed is affirmed. Because we find the term generic, evidence of de facto secondary meaning, or of an association of the generic term with applicant cannot change the result and make the term registrable. See In re Northland Aluminum Prods., Inc., 777 F.2d 1556, 227 USPQ 961, 964 (Fed. Cir. 1985).

If not generic has "hotels.com" acquired distinctiveness?

Applicant has requested, in its brief and at oral argument, that the Board consider and rule on its alternative claim of acquired distinctiveness, even in the event "hotels.com" is found to be generic. We agree that it is appropriate to do so. See Analog Devices, supra. If it is ultimately determined that our decision herein is incorrect and that "hotels.com" is not generic for the identified services, we would at least consider it to be a highly descriptive term requiring significant evidence of acquired distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1571, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) (The kind and amount of evidence of acquired distinctiveness required to secure a registration will necessarily vary with the subject matter for which registration is sought). In this case, applicant has provided significant evidence of acquired distinctiveness.

With its response to the second office action, applicant included a declaration from Gregory S. Porter, applicant's general counsel and secretary. Mr. Porter stated that, as of the December 18, 2003 date of his declaration, applicant was averaging 156,000 visitors a day at its website; that approximately 2,000 other web sites

included links to applicant's site; that in 2002 alone, approximately 30 million dollars were spent on advertising on national, local, network and cable television advertising, as well as on in-flight ads screened on airliners; that approximately one million dollars had been spent on print ads in travel-related publications, in-flight magazines and in publications of general circulation, such as The New Yorker; that approximately 29 million dollars had been spent on on-line ads; and that applicant has displayed its proposed mark on billboards at major U.S. airports, train stations and sports venues. Mr. Porter also submitted with his declaration the declarations of 64 individuals familiar with applicant's proposed mark and services.

To support its request for reconsideration of the final refusal of registration, applicant included the previously mentioned declaration of Linda Essary, applicant's compliance manager, dated August 3, 2004. Attached to this declaration, as already discussed, were numerous advertisements. Ms. Essary also attested to applicant's revenue of 945 million dollars in 2002, 1.32 billion dollars in 2003, and estimated that applicant's revenue for 2004 would be 1.58 billion dollars. In regard to cumulative amounts spent on advertising, Ms. Essary

testified to amounts far in excess of what Mr. Porter had reported less than a year earlier. Finally, Ms. Essary reported that the number of visitors to applicant's web site had increased to approximately 475,000 per day.⁶

This evidence would not render a generic term registrable, see Northland Aluminum, supra, but it would be sufficient to allow for registration of even a highly descriptive term.

Decision: The examining attorney's requirement that applicant provide a disclaimer of "hotels.com," because applicant's composite mark is not unitary and the term is generic, is affirmed. The refusal of registration in the absence of a disclaimer will be set aside and the mark published for opposition if applicant, no later than 30 days from the mailing date hereof, submits an appropriate disclaimer. See Trademark Rule 2.142(g).

In the event the term "hotels.com" is ultimately held not generic, the examining attorney's refusal to accept the evidence of acquired distinctiveness is reversed.

⁶ We also note that applicant relies on its claim of use of its mark since 1997, but that claim is to use of the mark "in another form," specifically, as "hotel.com." While we agree that "hotel.com" is so close to "hotels.com" that use of the former would be considered probative evidence of applicant's claim that the latter has become distinctive, we need not rely on this to find acquired distinctiveness in "hotels.com." The evidence discussed above is sufficient.

Hearing:
January 31, 2006

This Opinion is Not
Citable as Precedent of
the TTAB

Mailed:
October 24, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hotels.com, L.P.

Serial No. 76414272

On Request for Reconsideration

Gary D. Krugman, Kevin G. Smith and Jody H. Drake of
Sughrue Mion PLLC for Hotels.com, L.P.

Ingrid C. Eulin, Trademark Examining Attorney, Law Office
111 (Craig D. Taylor, Managing Attorney).

Before Walters, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Hotels.com, L.P., a limited partnership of Texas,
sought registration of a composite word and design mark
including the term HOTELS.COM in a stylized form of
lettering. The examining attorney required applicant to
include a disclaimer of "hotels.com," which the examining
attorney determined to be generic for the identified
services.

On appeal, the Board upheld the disclaimer requirement, agreeing that the term is generic. Applicant now seeks reconsideration of that decision. Specifically, applicant argues that even if the examining attorney is viewed as having established a prima facie case of genericness, a point that applicant does not concede but assumes for the purpose of its request for reconsideration, applicant provided direct evidence that more than 60 declarants from among the relevant public do not view the term HOTELS.COM as a generic term. Applicant contends the Board either did not consider this evidence or did not accord this evidence proper weight. "To the extent the Board found this evidence to be merely evidence of de facto secondary meaning, or merely evidence of an association of the generic term with Applicant, the Board's decision is believed to be erroneous." Req. for Recon., p. 4. Accordingly, applicant contends that our decision requires correction.

The direct evidence on which applicant relies as support for its request for reconsideration consists of 64 declarations submitted as attachments to a declaration of Gregory S. Porter, general counsel and secretary of applicant. The Porter declaration introduces the attached declarations with the following statement:

9. As a result of the extensive use and advertising of the HOTELS.COM mark in connection with Hotels.com, L.P.'s online services, the mark has come to be widely recognized by the public and industry as denoting Hotels.com, L.P.'s services. Attached hereto as Exhibit D are 64 declarations from customers, competitors, and vendors of Hotels.com, L.P., and other persons familiar with the online services provided by Hotels.com, L.P. under the HOTELS.COM mark.

Because of the introductory phrase in the above quoted paragraph, "[a]s a result of the extensive use and advertising of the HOTELS.COM mark," we construe this paragraph as referring back to the information provided on use and advertising in paragraphs 3-8 of the Porter declaration. These paragraphs in the declaration pertain to applicant's claim of acquired distinctiveness.

Before further discussing the declaration evidence and applicant's request for reconsideration, it will be helpful to review some of the procedural history of the application and appeal, so as to view the evidence in context. When the declarations were filed, applicant was maintaining the alternative positions that "hotels.com" is inherently distinctive, and that even if the term is not inherently distinctive, it has acquired distinctiveness. In its response to the first office action, applicant contended that "hotels.com" is inherently distinctive because no two entities can have the same internet domain name. Applicant

also argued that the term has, at least, acquired distinctiveness. The Porter declaration and the 64 declarations submitted therewith were included with applicant's response to the second office action, and were stated by applicant to constitute "evidence of 'secondary meaning.'" Response of December 19, 2003, p. 2.

In contrast to these responses to office actions, applicant did not pursue on appeal the argument that "hotels.com" is inherently distinctive. Applicant conceded in both its main brief and reply brief that the term is descriptive, but argued that the term is not generic and has acquired distinctiveness. We did not construe the Porter declaration and the declarations attached thereto as evidence that the declarants recognize the term "hotels.com" as inherently source indicating both because they were offered as evidence of secondary meaning and because the appeal did not present a claim of inherent distinctiveness. As recognized by applicant, however, we did consider the declarations as evidence of acquired distinctiveness.

In its request for reconsideration, applicant does not argue that the declarations should have been considered as evidence of inherent distinctiveness. However, applicant does argue that the declarations are not merely evidence of

de facto distinctiveness of a generic term, and should have been considered in the first instance as significant evidence of the "non-genericness" of "hotels.com."

We note that applicant, in the section of its main appeal brief wherein it argued that "hotels.com" is not generic, did not reference the declarations as support for this contention; rather, applicant expressly relied on the declarations only in that section of its main brief wherein it asserted that the term "hotels.com" has acquired distinctiveness. We find applicant's argument, raised for the first time in a request for reconsideration, that the declaration evidence should be considered as evidence on "non-genericness" to be inappropriate. However, to the extent that we did not expressly address these declarations as pertaining to the issue of "non-genericness" in our decision, we do so now.

A review of the declarations reveals that they are essentially form declarations. An index of the declarations lists 18 of them as "business declarations" and the remaining 46 as "consumer declarations." Each of the declarations sets forth not the declarant's own words, but a set of statements that vary very little. The first statement in each of the businessperson declarations states that the declarant is "engaged in and thoroughly acquainted

with the business of hotel reservations, transportation and travel agency services,"¹ while the first statement in each of the consumer declarations states only that the declarant is "acquainted with the hotel reservation, transportation and travel agency industry as a consumer." Each business declarant, save two, then states, "to me personally, and among those persons involved in the hotel reservation, transportation and travel agency industry, the term HOTELS.COM is not the common, generic name of any product, service, or field of study."² Each consumer declarant states, "to me personally, the term HOTELS.COM is not the common, generic name of any product, service, or field of study." Clearly, the second statement in each of the 64 declarations is the same, except that the business declarants purport to speak not only for themselves but also as to the understanding of others involved in the industry. By the remaining statements in each of the 64 declarations, each declarant states that the term

¹ One of the 18 business declarations does not use the words "engaged in" but does use the words "thoroughly acquainted with." Another (exh. D-6) does not use the language quoted above, but instead recites the name of the declarant, his employer and what he does on the job for his employer.

² One business declarant substitutes "persons thoroughly acquainted with in [sic]" for the words "persons involved in." The other business declarant (exh. D-6) that does not use the exact phrase quoted above speaks only for himself, not for others in the industry.

"hotels.com" is a mark and serves as an indication of source.

Applicant's current argument that the declarations are evidence of "non-genericness" makes a very fine distinction, and there is no evidence that the declarants were intending, by signing what are clearly form declarations, to make such a fine point. There is no indication that the declarants are familiar with the distinctions between inherently distinctive marks and terms that have acquired distinctiveness, or between a generic term and a descriptive term. See In re Pennzoil Products Co., 20 USPQ2d 1753, 1759 (TTAB 1991) (form declarations found to "lack persuasiveness on the issue of the primary significance of the term 'MULTI-VIS' to the purchasing public" when there was no indication that the declarants were "familiar with such technical concepts as mere descriptiveness, distinctiveness and the definition of a trademark.").

Each declaration bears a caption showing its relevance to the involved application and includes "Attorney Docket No. 2488.5." The statements that "hotels.com" is not generic, is a mark, and serves to indicate source are conclusory only. There are no explanations why the declarants believe these statements to be true. Further,

the caption to each declaration lists "MARK: HOTELS.COM & DESIGN." Thus, even if an individual asked to complete a declaration form had not reached an independent conclusion as to whether "hotels.com" was a mark or a generic term, the caption would suggest the answer. Form declarations that may not "actually reflect the views of the declarants" are entitled to "little weight." In re EBSCO Industries Inc., 41 USPQ2d 1913, 1916 (TTAB 1996).

The relevant public for determining genericness in this case is the general public, i.e., anyone who might need information about hotel rooms, or need to reserve a hotel room. Such a relevant public would include both business and leisure travelers, and the declarations submitted by applicant are asserted to be from both of these subclasses of the relevant public.³ The Porter declaration, however, explains that some of the businessperson declarations are from "customers" and "vendors" of applicant. Such businessperson declarants, being familiar with applicant, would not necessarily be reflective of the average business traveler not conditioned to associate "hotels.com" with applicant. See EBSCO Industries, supra (the only evidentiary value of

³ Tim Schmuckal, corporate counsel for Expedia, Inc., submitted declarations both as a businessperson and as a consumer.

declarations from declarants familiar with the applicant goes to the issue of acquired distinctiveness).

Finally, we note that 34 of the 64 declarations, including a majority of the consumer declarations, are from individuals employed by Interval Travel, Interval International Limited, or Interval International, Inc. (Interval declarants). Since 7 of the 34 Interval declarants are classified among the businessperson declarants that may already be familiar with applicant, we find it difficult to consider any real distinction between those 7 and the other 27 Interval "consumer" declarants. In other words, all 34 of these declarants may be particularly familiar with applicant and its use of "hotels.com." Similarly, there are also declarants from Collins & Scanlon LLP and from Expedia, Inc. listed in both the business and consumer lists of declarants. Thus, these declarants, too, may be particularly familiar with applicant.

Under these circumstances, we do not consider these declarants representative of the average member of the relevant public, be it a business traveler or a leisure traveler.

In conclusion, we do not find any error in our initial consideration of the evidence of these declarants, or in

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our decision not to accord the declarations significant probative value in determining how the relevant public perceives the term "hotels.com." The request for reconsideration is denied.